

***IN THE UNITED STATES PATENT AND TRADEMARK OFFICE***

Applicant: Gary A. Deeter et al.

Title: MODIFIED ANIONICALLY POLYMERIZED POLYMERS

Appl. No.: 10/710,654

Filing Date: 7/27/2004

Patent No.: 7,517,934

Grant Date: 4/14/2009

Examiner: MULLIS, Jeffrey C.

Art Unit: 1796

Confirmation Number: 4653

**“RENEWED PETITION” FOR REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants respectfully renew their request for reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent. The USPTO indicated in the letter of March 13, 2009, that a decision on the Applicants' initial request was being held in abeyance until after the actual patent date. As noted, the patent issued on April 14, 2009, as U.S. Patent No. 7,517,934.

The Patent Office determined that the patent was entitled to 64 days of PTA. Applicants believe that this PTA determination was made in accordance with the “Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)” published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-

year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of "overlap" are limited to "periods of time . . . [that] occur on the same day." *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." *Id.*

Applicants have recalculated the PTA for the captioned patent under the court's interpretation of the PTA statute, and have determined that the patent is entitled to 93 days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B): 392 days

(b) Total Applicant delay: 299 days

Final PTA Determination: 93 days

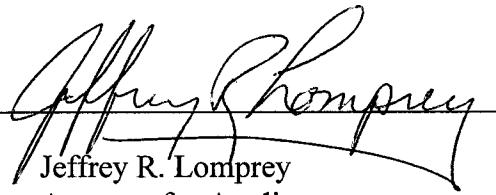
Applicants therefore respectfully request that the patent be accorded 93 days PTA.

The patent is not subject to a terminal disclaimer.

Because this is a renewed request, Applicants do not believe that any fee is due, the fee having been paid with the Applicants' original request on December 23, 2008. However, if a fee is due, and should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Respectfully submitted,

By



Jeffrey R. Lomprey  
Attorney for Applicant  
Registration No. 55,401

Date: April 24, 2009

FOLEY & LARDNER LLP  
Customer Number: 23524  
Telephone: (608) 258-4288  
Facsimile: (608) 258-4258

CLOSE WINDOW

All Cases **Patent Term Adjustment Calculation System**

Add a new event to this case

Docket Number: 018894-0113  
 Application Number: 10/710654  
 Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Application Filing Date	07/27/2004	0		
	14 month From Application date	09/27/2005	427		
Edit Delete	Restriction Requirement	10/26/2005	456	29	
Edit Delete	Restriction Requirement Response Received at PTO	11/22/2005	483		
Edit Delete	Non-Final Office Action	01/20/2006	542		
	Non-Final Office Action + 3 months	04/20/2006	632		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	07/20/2006	723		91
Edit Delete	Non-Final Office Action	10/03/2006	798		
	Non-Final Office Action + 3 months	01/03/2007	890		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	03/02/2007	948		58
Edit Delete	Non-Final Office Action	06/20/2007	1,058		
	3 Year Period Starts	07/27/2007	1,095		
	Non-Final Office Action + 3 months	09/20/2007	1,150		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	12/19/2007	1,240		90
Edit Delete	Final Office Action	02/25/2008	1,308		
	Final Office Action + 3 months	05/25/2008	1,398		
Edit Delete	Final Office Action Response Received at PTO	06/05/2008	1,409		
Edit Delete	Advisory Action	06/27/2008	1,431		
Edit Delete	Request For Continued Examination	07/24/2008	1,458	363	60
	3 Year Period Stopped	07/24/2008	1,458		
Edit Delete	Notice of Allowance	09/29/2008	1,525		
Edit Delete	Issue Fee Paid	12/24/2008	1,611		
Edit Delete	Patent Grant Date	04/14/2009	1,722		
				Totals:	392
				PTA:	299
					93

Created and maintained by



Version: 3.02.05

LOGIN: **Sharon Dudley**

IP: 10.24.4.200

Foley & Lardner LLP



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. Box 1450  
ALEXANDRIA, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

FOLEY & LARDNER LLP  
150 EAST GILMAN STREET  
P.O. BOX 1497  
MADISON WI 53701-1497

MAILED

MAR 13 2009

In re Application :  
Deeter, et al. :  
Application No. 10/710,654 :  
Filed: July 27, 2004 :  
Dkt. No.: 018894-0113 :  
::

OFFICE OF PETITIONS

PATENT TERM ADJUSTMENT

This decision is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705," filed December 23, 2008. This matter is being properly treated as a timely filed application for patent term adjustment pursuant to 37 CFR 1.705(b).

The Determination of Patent Term Adjustment under 35 USC 154(b) was mailed September 29, 2008. Applicants argue that the application is entitled to an additional adjustment of 363 days pursuant to 35 USC 154(b)(1)(B).

Applicants contest the adjustment insofar as it relates to the Office's failure to issue the patent within three years of the filing date of the application pursuant to 37 CFR 1.703(b) in view of Wyeth v. Dudas, No. 07-1492 (D.D.C. September 30, 2008).

To the extent that this application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being held in abeyance until after the actual patent date. Knowledge of the actual date the patent issues is ordinarily required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See, 37 CFR 1.703(b). It is noted that at the time of this decision, the patent has not issued.

Applicants are given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Applicants may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

RECEIVED  
MAK  
MJB

MAR 19 2009

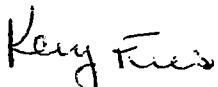
FOLEY & LARDNER  
MADISON, WI  
IP DOCK/INTG

With respect to the over 3 year calculation, rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

Receipt is hereby acknowledged of the required patent term adjustment application fee of \$200.00.

The application file is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (571) 272-3205.



Kery Fries  
Senior Patent Attorney  
Office of Patent Legal Administration  
Office of Deputy Commissioner  
for Patent Examination Policy